THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HOWARD W. DeMOORE
and
JOHN A. BRANSON

_____

Appeal No. 1998-0976
Application 08/379,722

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ON BRIEF

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Before BARRETT, FLEMING and BARRY, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 15 and 20 through 47. Claims 16 through 19 and 48 through 53 are withdrawn from consideration.

Independent claim 1 is reproduced as follows:

1. A method for supporting a processed substrate as it is transferred from a processing unit of a printing press, comprising the steps of:

providing a rotatable member having a substrate support surface thereon;

providing a base covering of electrically semi-conductive material having a frictional coefficient which is less than the frictional coefficient of the substrate support surface;

securing the semi-conductive base covering around the substrate support surface and in electrical contact with the rotatable member; and

rotating the rotatable member to support a processed substrate on the semi-conductive base covering.

The Examiner relies on the following references:

Köbler	4,599,943	July 15, 1986
DeMoore et al. (DeMoore)	5,052,384	Aug. 27, 1991
Schwöpfinger	5,320,042	June 14, 1994
		(filed June 2, 1992)

Claims 1 through 4, 7, 8, 11 through 13, 20 through 27 and 30 through 47 stand rejected under 35 U.S.C. § 103 as being unpatentable over DeMoore in view of Köbler. Claims 5, 6, 9, 10, 14, 15, 28 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over DeMoore in view of Köbler and Schwöpfinger.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs[1] and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 15 and 20 through 47 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the

[1] Appellants filed an appeal brief on March 6, 1997. Appellants filed a reply brief on August 5, 1997. The Examiner mailed a communication on September 10, 1997 stating that the reply brief has been entered and considered but no further by the Examiner is deemed necessary.

claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996)

(citing W. L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied,*** 469 U.S. 851 (1984)).

On page 3 of the answer, the Examiner states that DeMoore fails to teach that the base covering 62 is electrically conductive. The Examiner argues that Köbler recognizes that

an undesirable electrostatic charge is built up on the surface of rubber cylinders in the printing press during the printing operation and teaches providing an electrically conductive

layer 6 on the base covering 4 connected to the cylinder body, which is grounded, in an effort to carry away the electro-static charge build up on the cylinder surface. The Examiner directs us to the drawing figure and col. 2, line 10, through col. 3, line 26, of the Köbler reference. The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the base covering 62 of DeMoore with an electrically conductive layer connected to the cylinder body as taught by Köbler so as to alleviate the electrostatic charge build up problem on the cylinder surface.

Appellants argue on pages 5 through 7 of the brief, that there is no suggestion or motivation to substitute Köbler's aluminum conductive layer 6 in the place of DeMoore's non-conductive base covering 62. Appellants argue that Appellants' claims require that the underlying low friction, conductive transfer member makes direct electrical contact with the underlying conductive sheet support surface of the transfer cylinder. Appellants point out on page 7 of the brief that Köbler discloses that the felt underlay packing 4

is constructed of a nonconductive material (felt, paper or cardboard) and thus effectively blocks the radial transfer of charge from the rubber blanket 5. Appellants argue that, accordingly, Köbler is not properly combinable with DeMoore to support an obviousness rejection of the pending claims.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992)(***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). It is further established that such a suggestion may "come from the nature of a problem to be solved, leading inventors to look to references relating to

possible solutions to that problem." ***Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.***, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996)(***citing In re Rinehart***, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976)(considering the

problem to be solved in a determination of obviousness)). The Federal Circuit reasons in ***Para-Ordnance Mfg.*** 73 F.3d at 1088-89, 37 USPQ2d at 1239-40, that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bvious- ness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg.***, 73 F.3d at 1087, 37 USPQ2d at 1239 (***citing W. L. Gore***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-313). In addition, our reviewing court requires the Patent and Trademark Office to make specific findings on a suggestion to combine prior art references. ***In re Dembiczak***, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We note that Appellants' independent claim 1 recites "providing a base covering of electrically semi-conductive material having a frictional coefficient which is less than the frictional coefficient of the substrate support surface;

securing the semi-conductive base covering around the substrate support surface and in electrical contact with the rotatable member." Furthermore, we note that the only other independent claim, claim 11, recites "supporting the freshly printed side of the substrate on a semi-conductive base covering disposed on the support cylinder; conducting electrostatic charges from the freshly printed substrate to the semi-conductive base covering; and, conducting electrostatic charges from the semi-conductive base covering to the support cylinder." Therefore, we find that Appellants' scope of the claims before us require that the underlying low friction, conductive transfer member makes direct electrical contact with the underlying conductive sheet support surface of the transfer cylinder.

In col. 1, lines 14 through 37, Köbler teaches that it is necessary or desirable to cover the surface of the rubber blanket cylinder with a protective coating since the cylinder is in contact with aggressive chemicals. Köbler discloses that typical coatings are nickel, chromium, and

alloys as well as electrically non-conductive materials, such as ceramic, Teflon or

silicone. Köbler states that it has been found that a coating on the rubber blanket cylinder which is electrically non-conductive or only poorly conductive causes in due course damage to the surface of the cylinder. In col. 1, lines 45 through 56, Köbler states that it appears that the damage to the cylinder may be due to electrostatic charge which will build up on the blanket and which cannot be conducted away from the surface of the cylinder if the surface is non-conductive or electrically only poorly conductive. In col. 2, lines 10 through 21, Köbler teaches that the figure shows a rubber blanket cylinder C having a surface 1 which is coated with a protective coating 3 of electrically non-conductive or only semiconductive material, which is applied in order to protect the surface of the cylinder 1 from attack by corrosive or chemically aggressive materials. In col. 2, lines 22 through 33, Köbler discloses that a pad 4 is applied to the surface of the rubber blanket cylinder. The pad may be made

of paper, cardboard, felt, or the like. The pad 4 is beneath the rubber blanket 5. In col. 2, lines 34 through 62, Köbler teaches that it has been found that electrostatic charge will build up on
the insulating material forming the pad 4 and the blanket 5. Köbler teaches that the surface of the pad 4 which is in contact with the insulating protective layer has an electrically conductive layer or coating 6 applied thereon. Therefore, we find that Köbler teaches that the electrically conductive layer 6 is between the pad 4 and the protective coating 3 of the cylinder surface 1.

Thus, we find that Köbler is concerned with drawing off electrostatic charges that could be built up in between a pad 4 and protective layer 3 to prevent damage due to corrosion. Köbler is not concerned with the problem of electrostatic charge building up on the outer surface of the rubber blanket 5. Therefore, we fail to find any suggestion or desirability of placing Köbler's electrical conductive layer 6 in between DeMoore's base covering 62 and the flexible jacket covering 78. We fail to find that DeMoore or Köbler

recognizes the problem of electrical static charge building up between the base covering and the flexible jacket covering. Furthermore, upon our review of Schwöpfinger, we fail to find that Schwöpfinger supplies this missing piece as well.

In view of the foregoing, we have not sustained the rejection of claims 1 through 15 and 20 through 47 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

LEE E. BARRETT Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

MRF:psb

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Application 08/379,722

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